

REMARKS/ARGUMENTS

The election/restriction requirement dated September 18, 2006 has been considered. Claims 1-67 are pending in the application. Applicant hereby provisionally elects claims 1-15 of Invention I. Applicant traverses the restrictions between Inventions I, II, III, IV and IV.

In order to establish reasons for insisting upon restriction, the Examiner must explain why there would be a serious burden on the Examiner if restriction is not required. (See, MPEP § 808.01(a) which references MPEP § 808.02). To comply with this requirement, the Examiner must show by appropriate explanation one of the following (1) separate classification; (2) separate status in the art when they are classifiable together, or (3) a different field of search. (MPEP § 808.02).

The Examiner states that “there would be a serious burden on the examiner if restriction is not required because the inventions have acquired a separate status in their art due to their recognized divergent subject matter” (Office Action, Page 7).

Section 808.02 of the MPEP, under the heading “Establishing Burden,” states that “[s]eparate status in the art may be shown by citing patents which are evidence of such separate status.” The Applicants respectfully submit that the Examiner has failed to meet her burden and only provides a conclusory statement asserting that the inventions have separate status in the art. The Examiner does not explain or provide support in her conclusion that the subject matter of each respective invention has been recognized as having acquired separate status in the art.

Furthermore, the fact that all of the inventions are group together in class 607, subclass 4, supports the Applicant’s position that examination of the inventions together does not meet the serious burden requirement for proper restriction.

Moreover, restriction based on combination/subcombination classification requires that the subcombination be shown to have utility either by itself or in another materially different combination. (MPEP § 806.05(c)).

In support of the restriction between Inventions I and II and the restriction between Inventions II and III, the Examiner states that “[t]he subcombination [of Invention I] has separate utility such as treatment of asystole.” (Office Action, Pages 2 and 4). The Applicants submit that Inventions I, II and III are all directed to treating asystole.

Claim 1, the independent claim of Invention I, specifically recites asystole. Claims 37 and 58, the independent claims of Invention III, each specifically recite asystole.

Claim 16, the independent claim of Invention II, recites “energy delivery circuitry . . . configured to deliver . . . a pacing therapy deliverable at a rate lower than a bradycardia pacing rate.” (Emphasis added). While not using the word asystole, Claim 16 nevertheless refers to treatment of asystole, as can be understood by reference to the specification. For example, the specification states that “[i]n an embodiment in which asystole prevention pacing is also made available, the SCDP device 502 produces pacing pulses in accordance with a non-physiologic, life sustaining pacing therapy, such as pacing therapy deliverable at a rate lower than a bradycardia pacing rate.” (Page 20, Lines 15-18; emphasis added).

Therefore, the Examiner has not met her burden of showing that Inventions I, II and III represent inventions in which restriction is appropriate. Moreover, the Examiner has not met her burden of showing that the purported subcombinations have separate utility for the reason cited by the Examiner and restriction on that basis is improper.

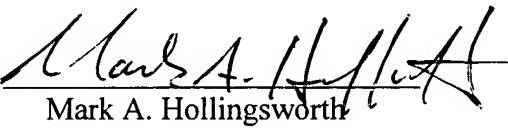
In regard to the restriction of Inventions I and III, the Examiner distinguishes these inventions by pointing out that Invention I recites use of a lead while Invention III does not. The Applicants respectfully submit that the addition of a lead does not present “a serious burden” when searching the prior art, particularly when both inventions already share the same class and subclass. (See MPEP § 808.01(a) which references MPEP § 808.02).

As such, for all of the reasons stated above, the Applicants request withdrawal of the restrictions between Inventions I, II, III, IV and V, and examination of those inventions together.

In view of the above, the Applicants respectfully request reconsideration and withdrawal of the requirement for restriction. If the Examiner would find it helpful to discuss this issue by telephone, the undersigned attorney of record invites the Examiner to contact him.

Respectfully submitted,

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